

basis for “means for inputting a particular procedure” in Claim 1. Pursuant to the Examiner’s suggestion, Claim 6 has been amended to depend from Claim 4, which includes the limitation “means for inputting a particular procedure.” Accordingly, it is respectfully submitted that this rejection should be withdrawn and, for the reasons set forth below, the claim be allowed to issue.

Claims 1-3, 5, 7-10, 12, 19-21 and 23-37 have been rejected under 35 U.S.C. 102(e) as being anticipated by the Boyer et al. U.S. Patent No. 6,208,973 (the Boyer ’973 patent). Claims 1-3, 5, 7-10, 12, 19-21 and 23-37 have been canceled from this application. A preliminary amendment adding the removed claims to copending U.S. Patent Application Serial No. 10/273,711 is being presently and contemporaneously submitted to the Patent and Trademark Office. Accordingly, Applicant does not waive its rights to the subject matter covered by the canceled claims. Rather, Applicant has removed the aforementioned claims from the present application solely in order to allow the allowed claims to proceed to issuance.

Claims 11 and 22 have been rejected under 35 U.S.C. 103(a) as being unpatentable over the Boyer ’973 patent. Claims 11 and 22 have been canceled from the present application. A preliminary amendment adding the removed claims to copending U.S. Patent Application Serial No. 10/273,711 is being presently and contemporaneously submitted to the Patent and Trademark Office. Accordingly, Applicant does not waive its rights to the subject matter covered by the canceled claims. Rather, Applicant has removed the aforementioned claims from the present application solely in order to allow the allowed claims to proceed to issuance.

Claims 4 and 6 stand rejected as being dependent upon a rejected base claim. Claim 4 depended from Claim 1. Claim 4 has been amended to include all of the limitations from Claim 1 and Claim 6, as described above, has been amended to depend from Claim 4. Accordingly, it is respectfully submitted that Claims 4 and 6 are in condition for allowance.

Claims 13 through 18 were deemed allowable by the Examiner. Claim 14 was inadvertently canceled in a preliminary amendment filed on June 5, 2002. New Claim 28, which is identical to the old Claim 14, has been added to restore the old Claim 14. It is respectfully requested that Claim 28 therefore should be allowed to issue.

Accordingly, allowance of Claims 4, 6, 13, 15-18 and 28, as amended, and expedited issuance is respectfully requested. Should anything further be required, the Examining Attorney is respectfully requested to telephone the undersigned at (312) 551-8300.

January 31, 2003
PATZIK, FRANK & SAMOTNY LTD.
150 South Wacker Drive
Suite 900
Chicago, Illinois 60606
Telephone: 312-551-8300
Facsimile: 312-551-1101

Respectfully submitted,

By

Max Shaftal

Registration No. 31,422

VERSION WITH MARKINGS TO SHOW CHANGES MADE

4. (Once Amended) [The system of Claim 1 wherein the eligibility determining means comprises] A system for determining eligibility of a participant in an insurance plan with respect to particular dental procedures performable by a dental care provider comprising:
- at least one computer having at least one data storage means, at least one input means, and at least one output means;
 - data pertaining to at least one participant stored in at least one database on the data storage means of a first of said at least one computer wherein at least a portion of said data is not locally stored on said first computer;
 - means associated with the at least one computer for determining eligibility of the participant in real time comprising:
 - means for inputting a participant identifier;
 - means for inputting a particular procedure necessitated by a participant;
 - means for searching the participant data stored in the at least one data storage means for the participant identifier; and
 - means for providing the participant stored data pertaining to the participant identifier to the output means of the at least one computer, to, in turn, provide data as to the eligibility of a participant for a particular procedure;
 - said input means being associated with at least said first computer for inputting an inquiry requesting information pertaining to said particular dental procedure in order

to access said participant data in real time and determine eligibility for said procedure in real time prior to providing said procedure without the need to send participant's data to said first computer from said data storage means in advance of said determination; and

- means associated with the at least one computer for recording utilization of benefits by the dental provider in real time.

6. (Once Amended) The system of claim [1] 4 wherein the means for inputting a particular procedure necessitated by a participant comprises means for inputting at least a procedure code, a tooth identification, and a positional identification as applicable to said procedure.

28. (New) The method of claim 13 further comprising the step of: accessing the inputted performed procedure data in real time.